

REMARKS

On or about October 20, 2006, Applicant's representative held an interview with the Examiner to point out that the pending office action (paper no. 20060922) is marked in the Summary as being both a final action and a non-final action. The Examiner directed the Applicant's representative to the "Conclusion" of the pending action wherein the action has no indication as being final, and therefore, the Examiner verified that this action **is a non-final action**. Applicant's representative would like to thank the Examiner for her time and attention to this matter.

Claim 18 is canceled.

New claims 19-21 are added. Support for the new claims is provided by the originally-filed application at least at, for example, Figs. 1-2.

Claim 13 is rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement wherein the Examiner states the specification lacks support for a probe base having a square cross section. The Examiner is mistaken. Applicant directs the Examiner's attention to page 10, lines 1-2 of the originally-filed application which states: "device 1 comprises a probe base 5 in the form of an elongated bar having a **few mm square** or a few mm diameter in section...." (emphasis added).

Claim 18 is rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. This claim is canceled, and therefore, this rejection is rendered moot.

Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Leonard, et al. (U.S. Patent No. 6,063,044). Claims 2, 8-9, 11-13, and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Leonard, et al. as applied to claim 1

above and in view of Arhan, et al. (U.S. Patent No. 4,566,465). Claims 3 and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Leonard, et al. in view of Huszar (U.S. Patent No. 4,432,476). Claims 10, 16 and 18 are rejected under 35 U.S.C. §103(a) as being unpatentable over Leonard, et al. in view of Imran (U.S. Patent No. 5,396,887).

Regarding the anticipation rejection against independent claim 1, claim 1 recites a probe base for being inserted into the canal part of the human body. The Examiner relies on the probe base 23 of Leonard to allegedly teach this limitation. However, Leonard specifically teaches probe base 23 is not to be inserted into the human body: "base 23 does not move with this downward force but remains in place **on the surface of the skin 70**, maintaining linear alignment therewith...." (col. 7, lines 8-12) (emphasis added). The Leonard base 23 is not to be inserted into the human body, and therefore, it is inconceivable that Leonard teaches probe base for being inserted into the canal part of the human body as positively recited by claim 1. Leonard fails to teach or suggest a positively recited limitation of claim 1, and therefore, claim 1 is allowable.

Claims 2-4 and 8-17 depend from allowable independent claim 1, and therefore, claims 2-4 and 8-17 are allowable for depending from an allowable independent claim.

Regarding the obviousness rejection against dependent claim 2 based on the combination of Leonard and Arhan, claim 2 recites said resilient arm member comprises a plurality of **spring members**. The Examiner correctly states that Leonard fails to teach this limitation and therefore relies on Arhan to allegedly teach this limitation. However, the Examiner relies on teachings of two arms 5 and 6 of Arhan to allege the teaching of the positively recited spring members (pg. 4 of paper no. 20060922). There is no teaching or

suggestion that the two arms 5 and 6 act as spring members or have resilience, and in fact, are only cross levers. However, the Examiner states the arms 5 and 6 are "equivalent structures and are capable of providing the function of expanding and retracting the plurality of probes." The Examiner is mistaken. Spring members, by definition, can be deformed and then return substantially to a previous shape, that is, the resiliency. Arms 5 and 6 are not equivalent structures to spring members as recited by claim 2 because such do not deform or return to previous shapes, do not have resiliency, and moreover, arms 5 and 6 only act as levers to translate the movement of a motor 18 and block elements 8 and 9. Arhan teaches that "rod 10 has been rotated by means of the motor 18, the block elements 8 and 9 move apart from or towards each other, so that the articulated elements 1, 2 and 3 simultaneously undergo an expansion or a retraction with the radius R of the cylindrical surface 15 on which the soles 7 lie, varying accordingly." Col. 3, lines 10-16. Accordingly, it is inconceivable that Arhan, singularly or in any combination, teaches the resilient arm member comprises a plurality of **spring members** as positively recited by claim 2. Claim 2 is allowable.

Moreover, the Examiner has provided no motivation or incentive why one would modify the Leonard device to have resilient arm member comprising a plurality of **spring members**, as is mandated by the Federal Circuit Court. The Examiner is respectfully reminded that the Federal Circuit Court in *In re Lee* provided a fairly comprehensive analysis of the requirements for a proper obviousness rejection, particularly the evidence needed to demonstrate a proper motivation to modify the device or method of a reference by teachings of another reference or source. Federal Circuit Court in *In re Lee* stated:

The essential factual evidence on the issue of obviousness is set forth in Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966)...When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the Graham factors).

"The factual inquiry whether to combine references must be thorough and searching." Id. It must be based on objective evidence of record....In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.")...This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983).

In re Lee, 277 F.3d 1338, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

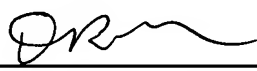
Accordingly, for a proper obviousness rejection, a motivation or incentive must be

presented that demonstrates why one would modify a device of a reference with teachings from another source or reference. The Federal Circuit Court has continually stressed this motivation requirement, given "the subtle but powerful attraction of a hindsight-based obviousness analysis," we require a "rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). It is clear that the motivation or incentive must be provided to demonstrate, based on objective evidence of record, why one would modify the Leonard device with teachings of Arhan to have resilient arm member comprising a plurality of **spring members** as positively recited by claim 2. The Examiner has failed to provide any motivation or incentive for modifying the Leonard device pursuant to the above Federal Circuit Court authority. Therefore, the obviousness rejection must fail and be withdrawn. In fact, the Leonard performs its intended function without this additional structure of the resilient arm member comprising a plurality of **spring members** as claimed, and therefore, *there can be no reasonably stated motivation or incentive for modifying the Leonard device to have that structure for which it does not need*. Claim 2 is allowable.

This application is now believed to be in immediate condition for allowance, and action to that end is respectfully requested. If the Examiner's next anticipated action is to be anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview prior to the issuance of any such subsequent action.

Respectfully submitted,

Dated: 3-30-07

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